

Remarks/Arguments:

A. Status of the Claims

Claims 51-79 were pending when the Office Action was mailed to Applicants on December 5, 2005. Claims 51, 69, 76, and 78 have been amended, claims 75 and 77 have been canceled, and claims 80-95 have been added. Support for the revised claims and the new claims can be found throughout the specification and claims as originally filed. See, for example, Abstract (“The nuclease inhibitors comprise anti-nuclease antibodies and non-antibody nuclease inhibitors”). No new matter has been added. Claims 51-74, 76, and 87-95 are currently pending.

B. The Anticipation Rejection Is Overcome

1. Summary of Rejection and the Anticipation Standard

Claims 51-54, 57-58, 59, 64, 68-69, 71-73, and 75-77 are rejected under 35 U.S.C. § 102(b) as being anticipated by Devaux *et al.* The Examiner contends that this reference discloses “five monoclonal antibodies (first, second, third, fourth, and fifth nuclease inhibitors) which inhibited the enzymatic degradation of DNA by *Staphylococcus aureus* nuclease to varying degrees. However, when mixed together the five Mabs were able to completely block the enzymatic degradation of DNA by *Staphylococcus aureus* nuclease.” The Action, page 3.

Applicants disagree. The claims prior to the amendments made above are not anticipated by Devaux *et al.* Additionally, the current claims are not anticipated by this reference.¹

In order to establish anticipation, the Examiner carries the burden of showing that a single reference discloses every element of Applicants’ claimed invention, either expressly or

¹ Applicants note that newly added independent claims 87, 88, 92, 93, 94, and 95 incorporate the subject matter of claims 56, 60, 65, 70, 74, and 79, respectively. Claims 56, 60, 65, 70, 74, and 79 are not rejected as being anticipated by Devaux *et al.* Further, as noted below, Applicants are filing Terminal Disclaimers to overcome all of the double patenting rejections. Therefore, the newly added independent claims are allowable over the cited art.

inherently. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327 (Fed. Cir. 2001); *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993).

2. Independent Claims 51 and 69 Are Not Anticipated By Devaux *et al.*

Independent claims 51 and 69 recite:

51. A method comprising:

- a) obtaining at least a first nuclease inhibitor further defined as a soluble anti-nuclease antibody;
- b) obtaining at least a second nuclease inhibitor further defined as a non-antibody nuclease inhibitor;
- c) obtaining a composition; and
- d) admixing the first nuclease inhibitor, the second nuclease inhibitor, and the composition to form an admixture;

wherein nucleases that may be present in the admixture are inhibited.

69. A method of performing a molecular biology technique comprising:

- a) obtaining at least a first nuclease inhibitor further defined as a soluble anti-nuclease antibody;
- b) obtaining at least a second nuclease inhibitor further defined as a non-antibody nuclease inhibitor;

and using the first and second nuclease inhibitors in the molecular biology technique.

As discussed by the Examiner, Devaux *et al.* appears to concern: "Monoclonal antibodies (Mab) specific for *Staphylococcus aureus* nuclease (nuclease) were examined for their capacity to inhibit the enzyme-mediated cleavage of DNA." Devaux *et al.*, Abstract. The mixtures in this reference appear to have "five inactivating Mabs." *Id.*

Devaux *et al.*, however, does not appear to disclose or suggest Applicants claimed methods. For instance there does not appear to be any disclosure of "a) obtaining at least a first nuclease inhibitor further defined as a soluble anti-nuclease antibody [and] b) obtaining at least a second nuclease inhibitor further defined as a **non-antibody nuclease inhibitor**." See claims 51

and 69 (emphasis added). Again, Devaux *et al.* appear to concern “[m]ixtures of five inactivating Mabs” and not Applicants’ claimed combination of “a soluble anti-nuclease antibody” and “a non-antibody nuclease inhibitor.”

Because Devaux *et al* fails to disclose every element of Applicants’ claimed invention, the anticipation rejection cannot be maintained. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d at 1327. Applicants therefore request that the rejection of claims 51-54, 57-58, 59, 64, 68-69, 71-73, and 75-77 under 35 U.S.C. § 102(b) as being anticipated by Devaux *et al.* be withdrawn.

C. The Double Patenting Rejections Are Overcome

There are two separate obviousness-type double patenting rejections: (1) claims 51-79 as being unpatentable over claims 1-33 of U.S. Patent No. 6,664,379; and (2) claims 51-79 as being provisionally unpatentable over claims 1-82 of U.S. Patent Application No. 10/786,875. Applicants are filing the appropriate terminal disclaimers along with the present response. In view of this, the obviousness-type double patenting rejections are overcome and should be withdrawn.

D. Conclusion

Applicants believe that this document is a complete response to the Office Action mailed on December 5, 2005. The present claims are in a condition for allowance and such favorable action is requested.

The Commissioner is hereby authorized to deduct any fees required by 37 C.F.R. §§ 1.116 to 1.21 as a result of the filing of this paper, including the terminal disclaimer fees required by 37 C.F.R. § 1.20(d), from Fulbright & Jaworski Deposit Account No. 50-1212/AMBI:052USC1.

The Examiner is requested to contact Applicant's representative at (512) 536-3035 with any questions or comments concerning this application.

Respectfully submitted,



Michael R. Krawzenek
Reg. No. 51,898
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
512.536.3020 (voice)
512.536.4598 (fax)

Date: March 1, 2006